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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/746,918	12/22/2000	Gopal Parupudi	MS1-695US	2766
22801	7590	01/24/2005	EXAMINER	
LEE & HAYES PLLC 421 W RIVERSIDE AVENUE SUITE 500 SPOKANE, WA 99201			NGUYEN, DUC M	
			ART UNIT	PAPER NUMBER
			2685	

DATE MAILED: 01/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/746,918	PARUPUDI ET AL.	
	Examiner	Art Unit	
	Duc M. Nguyen	2685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 22 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-27,29-48 and 50-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-27,29-48 and 50-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/20, 11/22/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to applicant's response filed on 9/20/04. Claims 2-27, 29-48, 50-58 are now pending in the present application.

Information Disclosure Statement

1. The references listed in the information disclosure statements submitted on 9/20/04 and 11/22/04 have been considered by the examiner (see attached PTO-1449).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims **3, 53, 55** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3, 53, 55 recite the limitation "information pertains **to a user** of the cellular phone". Since it is not clear what user information (i.e, age or personal information) would modify the behavior of the phone, and since the specification also fails to describe this user information (i.e, see Specification, page 55, lines 20-25), it is respectfully request that the Applicant either amends the specification or provide in the next response a specific user information (i.e, age, male or female) that would modify the behavior of the phone. In the rejection below, the

Art Unit: 2685

user location would be used as "information pertains to a user of the cellular phone".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims **36, 38, 40, 41** are rejected under 35 U.S.C. 102(e) as being anticipated by **Kuwahara** (US Patent Number **6,389,288**).

Regarding claims **36, 41**, **Kuwahara** discloses a mobile terminal (cellular phone) capable of executing location-related services such as phone settings, call settings (Figs. 1, 13, 21, and col. 7, line 52 - col. 8, line 52), which would include all the claimed limitations, comprising

defining one or more class types (see **Fig. 21** regarding Office, meeting room, home) each of which can be associated with a location (Zones) for which a particular cellular phone behavior is desired (execution service) ; and

associating attributes (execution service) with the one or more class types (Office, meeting room, home), the attributes defining cellular phone behavior.

Art Unit: 2685

Regarding claims **38, 40**, they are interpreted and rejected for the same reason as set forth in claim **6** above. In addition, **Kuwahara** discloses the behavior pertains to "ringer mode on/off" (see sound or vibration, Figs. 13, 21) and call forwarding behavior (see setting of call destination, col. 9, lines 3-5) as claimed.

4. Claims **50-53** are rejected under 35 U.S.C. 102(e) as being anticipated by **Evans et al (US 6,327,535)**.

The applied reference has a common assignee and inventors with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding claims **50-52**, **Evans** discloses a location-aware system wherein one or more hierarchical tree structures having nodes, each node being capable of corresponding to either a physical or logical location and using the location information to traverse at least portions of the one or more tree structures to ascertain the present location, this would include all the claimed limitations (see Figs. 1-5, Abstract, col. 4, lines 12-0 and col. 16, lines 9-30).

Regarding claim **53**, it is interpreted and rejected for the same reason as set forth in claim **50** above. In addition, the user location would read on the information pertaining to a user as claimed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims **5, 48** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Valentine et al (US 6,011,973)**.

Regarding claim **5**, **Valentine** discloses a method for enable or disable the operation of a cellular phone, comprising :

One or more processor configured to:

receive information that pertains to a current context of the cellular phone
(see Fig. 1, col. 2, line 30 – col. 3, line 3);

determine the current context based on the information (see Fig. 1, col. 2, line 30 – col. 3, line 3);

modify at least one behavior of the cellular phone responsive to the current context, wherein at least one of said one behavior is defined by a third

party (see Fig. 1, col. 2, line 30 – col. 3, line 3), wherein the network 170 would read on a third party as claimed.;

Here, although **Valentine** is silent on the application program interface, it is noted that in order to receive information for determining the position coordinates of the mobile and enable/disable the operation according to the position coordinates, a microprocessor or application program interface would obviously be needed to carry out the above process. Therefore, the claimed limitation is made obvious by **Valentine** for providing an application program interface as claimed, in order to receive and process information for utilizations.

Regarding claim **48**, it is rejected for the same reason as set forth in claim **5** above. In addition, **Valentine** discloses an on-board componentry as claimed (see Fig. 1).

6. Claims **6-12, 14-35, 37, 39, 42-47, 54-55, 57-58** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kuwahara** (US Patent Number **6,389,288**) in view of **Valentine**.

Regarding claims **6, 58**, **Kuwahara** discloses a mobile terminal (cellular phone) capable of executing location-related services such as phone settings, call settings (Figs. 1, 13, 21, and col. 7, line 52 - col. 8, line 52), which would include all the claimed limitations, wherein the receiving on "reported location information" would read on "wirelessly receiving information that pertains to a context " as claimed, the "setting of incoming calls alert method or screening" as shown in Fig. 13 would read on "modifying at least one behavior of the cellular phone responsive to the context", location information from several mobile

Art Unit: 2685

communication networks would read on “different type of context providers” as claimed (see col. 7, lines 60-63), and it is clear that after receiving location information from mobile communication networks, the mobile terminal using only its phone and its associated on-board componentry (see Fig. 1) to determine its location (context) as claimed (see col. 8, lines 1-38).

However, **Kuwahara** fails to disclose at least one of behavior is defined by a third party. However, in an analogous art, **Valentine** discloses a method for enable or disable the operation of a cellular phone based on the location information (see Fig. 1, and col. 2, line 30 – col. 3, line 3), wherein a behavior is defined by a third party (network 170). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further incorporate the above teaching of **Valentine** to **Kuwahara** for defining the allowability of operating the cellular phone based on location information, thereby providing at least one behavior is defined by a third party as claimed, for preventing the phone operating in an hazardous area such as inside an airplane (see Valentine, col. 1, lines 36-40).

Regarding claims **8-9, 11-12, 14-18, 21-27, 29-30**, they are interpreted and rejected for the same reason as set forth in claim **6** above. In addition, **Kuwahara** discloses

- multiple different context providers (see mobile communication networks in col. 8, lines 1-15);
- sound or vibration would read on “ringer mode on/off” (see Figs. 13, 21);
- computer-readable media (see control unit 403 in Fig. 4);

Art Unit: 2685

- change behavior when no longer at the current location (see steps S43, S44 in Fig. 25);

- location type (office, meeting room) with attributes (setting of screening, alert mode) defining a behavior (see area names and zones in Figs. 13, 21);

- call forwarding behavior (see setting of call destination, col. 9, lines 3-5);

Regarding claims **36, 41**, they are interpreted and rejected for the same reason as set forth in claim **6** above. In addition, **Kuwahara** defines class types (see home, office, library in Fig. 13), each one is associated with a location (see Zones in Fig. 13) and various attributes (see setting of screening, alert mode in Fig. 13) defining a behavior as claimed.

Regarding claims **38, 40**, they are interpreted and rejected for the same reason as set forth in claim **6** above. In addition, **Kuwahara** discloses the behavior pertains to "ringer mode on/off" (see sound or vibration, Figs. 13, 21) and call forwarding behavior (see setting of call destination, col. 9, lines 3-5) as claimed.

Regarding claims **54, 57**, they are interpreted and rejected for the same reason as set forth in claim **6** above. In addition, the report location information detecting means 1 in Fig. 1 would read on the "context service module", and the report location information managing means 2 would read on the "application program interface" as claimed.

Regarding claim **55**, it is interpreted and rejected for the same reason as set forth in claim **54** above. In addition, the user location would read on the information pertaining to a user as claimed.

Art Unit: 2685

Regarding claims **33, 35, 46-47**, they are interpreted and rejected for the same reason as set forth in claim **31** above. In addition, **Kuwahara** discloses ringer mode on/off (sound or vibration) and call forwarding as claimed (see Fig. 13, 21 and col. 9, lines 3-5).

Regarding claims **31, 42**, they are interpreted and rejected for the same reason as set forth in claim **6** above. In addition, since the reported location information (see Zones 1, 2, 3 in Fig. 14 B) is pertaining to the user defined area (see "home" in Fig. 14 B), which is also pertaining to the class type "home" with the broadest reasonable interpretation, the claimed limitations are made obvious by **Kuwahara** for wirelessly transmitting information (location information) **pertaining** to the class type (home) as claimed.

Regarding claims **7, 19, 32, 37, 45**, **Kuwahara** discloses all the claimed limitations, see claim **6** above, except for the phone setting is on/off. However, to turn the phone off when in a restricted area such as hospital is known in the art (Official Notice). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify **Kuwahara** for setting the phone on/off as claimed, for preventing radiation hazardous when in a restricted area such as hospitals.

Regarding claims **10, 20, 34, 39**, **Kuwahara** discloses all the claimed limitations, see claim **6** above, except for the pitch of a ringer. However, since setting the pitches of phone ringer for different locations is known in the art (Official Notice), it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify **Kuwahara** for setting the pitches of a

Art Unit: 2685

ringer at different locations as claimed, for audibly alerting a user of an incoming call at the best performance for each environment within which it is placed.

Regarding claims **43-44**, they are interpreted and rejected for the same reason as set forth in claim **42** above. In addition, **Kuwahara** discloses providing a transmitter (base station) at the location and the behavior is defined by the phone setting as claimed (see Figs. 14A and 21).

7. Claims **24-27, 29-30, 58** are rejected under 35 U.S.C. 103(a) as being unpatentable by **Kowaguchi et al** (US Patent Number **6,201,973**) in view of **Valentine**.

Regarding claims **24, 58, Kowaguchi** discloses a mobile terminal (cellular phone) capable of executing location-related transmission inhibition mode, comprising

- receiving means configured to wireless receive multiple different forms of information pertains to a current location of a cellular phone and use said multiple different forms of information pertains to ascertain the current location (see Figs 6-7 and col. 2, lines 9-28);
- means to modify at least one behavior (inhibition transmission) associated with the cellular phones responsive to said information (see col. 2, lines 5-8).

Here, although **Kowaguchi** is silent on at least one behavior is defined by a third party, it is noted that such inhibition transmission at hazardous areas would have been obviously defined by the service provider (or the network) as

Art Unit: 2685

disclosed by **Valentine** (see Fig. 1, and col. 2, line 30 – col. 3, line 3). Therefore, the claimed limitations are made obvious by **Kowaguchi and Valentine** for defining a behavior by a third party as claimed, for preventing the phone operating in an hazardous area such as inside a hospital or airplane.

Regarding claim **25**, it is rejected for the same reason as set forth in claim **24** above. In addition, **Kowaguchi** further discloses the information (location information) pertains to cellular phone setting (transmission inhibition mode or normal mode) that are associated with the current location (see Figs 4-5).

Regarding claim **26**, it is rejected for the same reason as set forth in claim **24** above. In addition, it is clear that the transmitting location information from base stations pertains with a defined location type of which the location is an instance as claimed.

Regarding claim **27**, it is rejected for the same reason as set forth in claim **24** above. In addition, it is clear that **Kowaguchi** would disclose a modify means as claimed when it is no longer at the current location (see Fig. 5).

Regarding claims **29-30**, they are rejected for the same reason as set forth in claim **24** above. In addition, it is clear that the transmitting location information from base stations is associated with a location type (i.e, hospital) that has attributes that define a cellular phone behavior/settings (transmission inhibition, see Fig. 4).

Art Unit: 2685

8. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable by **Kuwahara** in view of **Valentine**, and further in view of **Te-eni** (PCT WO 99/55102).

Regarding claim 13, **Kuwahara** discloses all the claimed limitations, see claim 6 above, except for receiving phone setting information. However, **Te-eni** discloses a mobile terminal (cellular phone) capable of executing location-related services such as phone settings based on different environments such as hospital airplane (see col. 3, line 22 - col. 4, line 14), wherein an application interface is configured to wirelessly receive phone setting information (see col. 21, lines 1-4). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the above teaching of **Te-eni** to **Kuwahara** for setting the phone behavior according to a command received in a restricted area as well, for obeying regulations of the restricted area when it is located therein.

9. Claim 56 is rejected under 35 U.S.C. 103(a) as being unpatentable by **Kuwahara** in view of **Valentine**, and further in view of **Wax** (US Patent Number 6,104,344).

Regarding claim 56, **Kuwahara** discloses all the claimed limitations, see claim 6 above, except for a hierarchical tree structure to ascertain the present location. However, **Wax** discloses a hierarchical tree structure for determining a geographical location from measured wireless signals (see Fig. 3, col. 7, line 34 – col. 8, line 54). Here, since **Kuwahara** discloses a Boolean operation is used

Art Unit: 2685

for ascertain the present location (see col. 8, lines 1-29), and since **Kuwahara** and **Wax** both disclose a method for searching a location, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the above teaching of **Wax** to **Kuwahara** for using a hierarchical tree structure searching as well, for improving the performance of the location calculation.

10. Claims **2-3, 5, 6, 11, 14** are rejected under 35 U.S.C. 103(a) as being unpatentable by **Alperovich et al** (US Patent Number **6,233,448**).

Regarding claim **5**, **Alperovich** discloses a method and apparatus for automatic activating/deactivating features (read on modify phone behaviors/settings) based on the position of a mobile station (see Abstract), comprising ;

- receiving information pertains to a current context (location) of a cellular phone (see col. 3, lines 29-52);
- determining the current location (see col. 3, lines 29-52);
- modify at least one behavior of the cellular phones (activating a

feature), wherein at least one behavior is defined by a third party (see **col. 5, lines 21-28**). Here, in this alternative embodiment, since the data array is stored at the HLR, it is clear that the behavior is defined by the network (a third party). Therefore, when the data array is stored in a SIM card (see **col. 4, lines 16-19**), it would have been obvious that such SIM card would have been obviously pre-programmed by the network, in order to activate a feature in accordance with the subscriber plan (i.e, whether the subscriber agrees to pay for long distances or

Art Unit: 2685

roaming fees). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above teaching of **Alperovich** for defining at least one behavior of the cellular phone by a third party (or network) as claimed, in order to enforce, control and activate a feature in accordance with the subscriber plan.

In addition, although **Alperovich** is silent on the application program interface, it is noted that in order to receive information for determining the position coordinates of the mobile and activating pre-selected features according to the position coordinates (see Fig. 2 and col. 7, lines 26-38), a microprocessor or application program interface would obviously be needed to carry out the above process. Therefore, the claimed limitation is made obvious by **Alperovich** for providing an application program interface as claimed, in order to receive and process information for utilizations.

Regarding claim 2, it is rejected for the same reason as set forth in claim 5 above. In addition, since **Alperovich** discloses a variety of methods for calculating a position based on GPS signals or from signals received from a plurality of base stations (see col. 3, lines 29-52). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the above teaching of **Alperovich** for providing a location service module as claimed, for improving the position accuracy by utilizing a plurality of signals from different providers so that the most reliable signal could be used for location estimation (i.e, GPS signals is not reliable when the mobile is located inside an urban area having many high-rise buildings).

Art Unit: 2685

Regarding claim **3**, it is interpreted and rejected for the same reason as set forth in claim **5** above. In addition, the user location would read on the information pertaining to a user as claimed.

Regarding claims **6, 14**, they are rejected for the same reason as set forth in claim **2** above.

Regarding claim **11**, it is rejected for the same reason as set forth in claim **6** above. In addition, Alperovich discloses the behavior pertains to forwarding calls (see col. 5, lines 1-20).

11. Claims **4, 56** are rejected under 35 U.S.C. 103(a) as being unpatentable by **Alperovich** in view of **Wax** (US Patent Number **6,104,344**).

Regarding claim **4**, **Alperovich** discloses all the claimed limitations, see claim **5** above, except for a hierarchical tree structure to ascertain the present location. However, **Wax** discloses a hierarchical tree structure for determining a geographical location from measured wireless signals (see Fig. 3, col. 7, line 34 – col. 8, line 54). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the above teaching of **Wax** to **Alperovich** for using a hierarchical tree structure in determining a location as well, for improving the performance of the location calculation.

Regarding claim **56**, it is interpreted and rejected for the same reason as set forth in claim **4** above, wherein the “location information” such as GPS signals would read on the “phone context”.

Art Unit: 2685

12. Claims 7-12, 14-27, 29-47, 54-55, 57-58 are rejected under 35

U.S.C. 103(a) as being unpatentable by **Alperovich** in view of **Kuwahara** (US Patent Number 6,389,288).

Regarding claim 8, **Alperovich** discloses all the claimed limitations, see claim 6 above, except for activating phone setting features. However, **Kuwahara** discloses a mobile terminal (cellular phone) capable of executing location-related services such as phone settings, call settings (Figs. 1, 13, 21, and col. 7, line 52 - col. 8, line 52). Since **Alperovich** and **Kuwahara** both discloses a method for modifying a phone behavior based on the location, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the above teaching of **Kuwahara** to **Alperovich** as well, for setting the phone operations at different locations as claimed, for alerting a user of an incoming call at the best performance for each environment within which it is placed.

Regarding claims 9, 11-12, 14-18, 21-27, 29-30, they are interpreted and rejected for the same reason as set forth in claim 8 above. In addition,

Kuwahara discloses

- multiple different context providers (see col. 8, lines 1-15);
- sound or vibration would read on "ringer mode on/off" (see Figs. 13, 21);
- computer-readable media (see control unit 403 in Fig. 4);
- change behavior when no longer at the current location (see steps S43, S44 in Fig. 25);
- location type (office, meeting room) with attributes (setting of screening, alert mode) defining a behavior (see area names and zones in Figs. 13, 21);

Art Unit: 2685

- call forwarding behavior (see setting of call destination, col. 9, lines 3-5);

Regarding claims **31, 42**, they are interpreted and rejected for the same reason as set forth in claim **8** above. In addition, since the reported location information (see Zones 1, 2, 3 in Fig. 14 B) is pertaining to the user defined area (see "home" in Fig. 14 B), which is pertaining to the class type "home", with the broadest reasonable interpretation, the claimed limitations are made obvious by **Alperovich** and **Kuwahara** for wirelessly transmitting information (location information) **pertaining** to the class type (home) as claimed.

Regarding claims **33, 35, 46-47**, they are interpreted and rejected for the same reason as set forth in claim **31** above. In addition, **Kuwahara** discloses ringer mode on/off (sound or vibration) and call forwarding as claimed (see Fig. 13, 21 and col. 9, lines 3-5).

Regarding claims **36, 41**, they are interpreted and rejected for the same reason as set forth in claim **8** above. In addition, **Kuwahara** defines class types (see home, office, library in Fig. 13), each one is associated with a location (see Zones in Fig. 13) and various attributes (see setting of screening, alert mode in Fig. 13) defining a behavior as claimed.

Regarding claims **38, 40**, they are interpreted and rejected for the same reason as set forth in claim **8** above. In addition, **Kuwahara** discloses the behavior pertains to "ringer mode on/off" (see sound or vibration, Figs. 13, 21) and call forwarding behavior (see setting of call destination, col. 9, lines 3-5) as claimed.

Regarding claims **54, 57-58**, they are interpreted and rejected for the same reason as set forth in claim **8** above. In addition, the report location information detecting means 1 in Fig. 1 would read on the "context service module" and the report location information managing means 2 would read on the "application program interface" as claimed (see Kuwahara, Fig. 1).

Regarding claim **55**, it is interpreted and rejected for the same reason as set forth in claim **8** above. In addition, the user location would read on the information pertaining to a user as claimed.

Regarding claims **7, 19, 32, 37, 45**, **Alperovich** and **Kuwahara** discloses all the claimed limitations, see claim **8** above, except for the phone setting is on/off. However, to turn the phone off when in a restricted area such as hospital is known in the art (Official Notice). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify **Alperovich** and **Kuwahara** for setting the phone on/off as claimed, for preventing radiation hazardous when in a restricted area such as hospitals.

Regarding claims **10, 20, 34, 39**, **Alperovich** and **Kuwahara** discloses all the claimed limitations, see claim **8** above, except for the pitch of a ringer. However, since setting the pitches of phone ringer for different locations is known in the art (Official Notice), it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify **Alperovich** and **Kuwahara** for setting the pitches of a ringer at different locations as claimed, for audibly alerting a user of an incoming call at the best performance for each environment within which it is placed.

Art Unit: 2685

Regarding claims **43-44**, they are interpreted and rejected for the same reason as set forth in claim **42** above. In addition, **Kuwahara** discloses providing a transmitter (base station) at the location and the behavior is defined by the phone setting as claimed (see Figs. 14A and 21).

Double Patenting

13. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

14. Claims **50-53** are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6, 28-34 of U.S. Patent No. 6,327,535. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both direct to a hierarchical tree structures having nodes, each node being capable of corresponding to either a physical or logical location; and using the location information to traverse at least portions of the one or more tree structures to ascertain the present location, whereas it would have been obvious to apply the

Art Unit: 2685

hierarchical tree structures to a cellular phone in place of a mobile computing device and would work equally well.

15. Claims 50-53 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-48 of copending Application No. 09/746,924. Although the conflicting claims are not identical, they are not patentably distinct from each other because because they both direct to a hierarchical tree structures having nodes, each node being capable of corresponding to either a physical or logical location; and using the location information to traverse at least portions of the one or more tree structures to ascertain the present location, whereas it would have been obvious to apply the hierarchical tree structures to a cellular phone in place of a mobile computing device and would work equally well.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

16. Applicant's arguments with respect to claims 5, 6, 15, 17, 24, 29, 31, 50, 51, 54, 58 have been considered but are moot in view of the new ground(s) of rejection.

As to claims 36, 41 regarding the class types, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., Applicant's argument regarding the differences between Applicant's class types and Kuwahara's class

Art Unit: 2685

types (home, office) on pages 34-35 such as limited to fixed geographic location) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore, the examiner believes that the area vector names such as Home, Office, Meeting room in Fig. 21 of Kuwahara's reference would read on "class types" as claimed, and their corresponding execution service such as vibrator, sound alerts would read on "attributes defining phone behavior" as claimed.

Examiner's note: this application uses the term "context" which has a very broad meaning. Therefore, Applicant be aware that any information that can be used to modify the behavior of the cellular phone would read on the term "context" as claimed.

As to claims 3, 53, 55 regarding the limitation "information pertains to a **user** of the cellular phone", the examiner has withdrawn the 112 first rejection. However, since it is not clear what user information (i.e, age or personal information of a user) would modify the behavior of the phone, and since the specification also fails to specifically describe this user information (i.e, see Specification, page 55, lines 20-25, not on page 5 as cited by the Applicant in the response), it is respectfully request that in the next response, the Applicant either amends the specification or provide a specific user information (i.e, age, male or female) that would modify the behavior of the phone so that the response would clarify the subject matter of the claims and can be placed of record.

Art Unit: 2685

Conclusion

17. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314 (for formal communications intended for entry)

(for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington VA, Sixth Floor (Receptionist).

Any inquiry concerning this communication or communications from the examiner should be directed to Duc M. Nguyen whose telephone number is (703) 306-4531, Monday-Thursday (9:00 AM - 5:00 PM). Or to Vivian Chin (Supervisor) whose telephone number is (703) 308-6739.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Duc M. Nguyen

Jan 21, 2005

